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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,324

09/16/2005

Osamu Nabeya

2005-1469A

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513 7590 05/30/2008

WENDEROTH, LIND & PONACK, L.L.P.

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SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

SMITH, NICHOLAS A

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

05/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,324	<b>Applicant(s)</b> NABEYA ET AL.	
	<b>Examiner</b> NICHOLAS A. SMITH	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 16-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/16/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1-14 and 16-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 25 February 2008.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by JP2002-292523 (JP'523) as submitted on Applicant's Information Disclosure Statement on 16 September 2005.

4. JP'523 discloses a method of processing a substrate comprising using a mechanical processing section (Figures 11-13) and an electrolytic processing section with an ion-exchanger and processing electrode and applying a voltage while ion-exchanger is contacting the workpiece (abstract and Figure 1). Both Figures 11-13 and Figure 1 show that there is a method of moving the workpiece relative to the processing electrode and the workpiece relative to the mechanical processing section.

5. Claims 15 and 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02103771 A1 (WO'771) of which US 7101465 B2 will be referred to for column and line number citations.

6. In regards to claim(s) 15 and 31-32, WO'771 discloses a method of processing a substrate comprising using a mechanical processing section (Figures 11-13) and an electrolytic processing section with an ion-exchanger and processing electrode and applying a voltage while ion-exchanger is contacting the workpiece (abstract and Figure 1), and both a method of moving the workpiece relative to the processing electrode and the workpiece relative to the mechanical processing section (col. 26, line 4 to col. 29, line 42; Figures 26-34). WO'771 also discloses a method wherein electrolytic processing occurs only and after it has been processed with a mechanical processing section (col. 26, line 4 to col. 29, line 42; Figures 26-34).

7. In regards to claim(s) 29-30, WO'771 discloses a method of providing a fixed-abrasive process section and an electrolytic processing section with a feeding electrode and a processing electrode and applying a voltage, and both a method of moving the workpiece relative to the electrolytic processing section and the workpiece relative to the fixed-abrasive section (col. 26, line 4 to col. 29, line 42; Figures 26-34). WO'771 also discloses a method wherein electrolytic processing occurs only and after it has been processed with a fixed-abrasive section (col. 26, line 4 to col. 29, line 42; Figures 26-34).

8. Claims 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Talieh et al. (US 6328872 B1) as submitted on Applicant's Information Disclosure Statement on 16 September 2005.

9. Talieh et al. discloses a method of providing a fixed-abrasive process section and an electrolytic processing section with a feeding electrode and a processing electrode and applying a voltage, and both a method of moving the workpiece relative to the electrolytic processing section and the workpiece relative to the fixed-abrasive section (col. 3, line 28 to col. 6, line 65; Figures 2-4). Talieh et al. also discloses a method wherein electrolytic processing occurs only and after it has been processed with a fixed-abrasive section (col. 3, line 28 to col. 6, line 65; Figures 2-4).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICHOLAS A. SMITH whose telephone number is (571)272-8760. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy Tsang-Foster can be reached on (571)-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1795

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D Wilkins, III/  
Primary Examiner, Art Unit 1795

NAS